

Appl. No. : 10/509,226
Filed : April 14, 2005

REMARKS

Claim 6 has been amended to incorporate the limitation of claim 15 and accordingly, claim 15 has been canceled. Claim 14 has been rewritten in independent form including all of the limitations of claim 6 upon which claim 14 is dependent. No new issue or no new matter has been raised. Applicant respectfully requests entry of the amendments and reconsideration of the application in view of the amendments and the following remarks.

Rejection of Claims 3-6, 9, and 11-22 Under 35 U.S.C. § 103

Claims 3-6, 9 and 11-22 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Toyoda (JP2003-183453A). Claim 6 is independent and has been amended, claim 15 has been canceled, and claim 14 has been rewritten in independent form including all of the limitations of claim 6. Applicant respectfully traverses this rejection.

Claim 6 recites: A clear coated paper comprising a base paper coated with 0.001 to 1 g/m² by solid content of a slipping property imparting agent for clear coat, said slipping property imparting agent comprising a copolymer whose constituents are unsaturated olefin (constituent (a)) and unsaturated carboxylic acid (carboxylate) (constituent (b)), wherein said copolymer contains 50 to 99 mol percent of constituent (a) and 50 to 1 mol percent of constituent (b) to the total mol number of constituents (a) and (b) combined, wherein the copolymer has a number-average molecular weight is 500-50,000.

The Examiner states: "Toyoda does not teach the claimed coating weight. However, Toyoda teaches the particles should be included in an ink composition (emphasis added)."

First, the subject matter of claim 6 is a clear coated paper, whereas Toyoda teaches an ink composition. The Examiner assumes that coating a base paper with a coating agent is the same as printing a paper with ink. However, coating is not equivalent to printing in the art.

It is well settled that during patent examination, the pending claims must be "given their broadest reasonable interpretation consistent with the specification." *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000) It is also well settled that the broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999)

Appl. No. : 10/509,226
Filed : April 14, 2005

The instant specification or Toyoda does not teach or suggest that an ink composition can be used as a clear coat of paper. Further, those skilled in the art cannot reach the interpretation that a coated paper can be a paper coated with ink. "Coated paper is paper which has been coated by an inorganic compound to impart certain qualities to the paper, including weight and surface gloss, smoothness or ink absorbency (emphasis added)." ("Coated paper" - Wikipedia, a copy is attached as Exhibit A.) "An ink is a liquid containing various pigments and/or dyes used for colouring a surface to render an image or text (emphasis added)." ("Ink" - Wikipedia, a copy is attached as Exhibit B.) Thus, coating is for providing certain qualities to a paper, whereas ink is for providing an image or text on a paper. Further, by definition, ink cannot constitute a clear coat. Coating and ink are very different and those skilled in the art cannot reach the interpretation that coating and ink are equivalent. The Examiner's interpretation that coating and ink are equivalent is inconsistent with the specification and also inconsistent with the interpretation that those skilled in the art would reach.

Since the instant specification or Toyoda does not teach or suggest that an ink composition can be used as a coating of paper, not all limitations of claim 6 are taught or suggested by Toyoda. Accordingly, claim 6 cannot be *prima facie* obvious over Toyoda.

Second, Toyoda is directed to an ink composition which gives anti-wearing and anti-blocking properties to the ink (paragraph [0138]). The Examiner states that it would be obvious to apply the anti-blocking ethylene unsaturated carboxylic acid composition taught in Toyoda. However, "blocking" is "undesirable sticking together of painted surfaces when pressed together under normal conditions (emphasis added)." ("Blocking" - Coating Guide -- Paint Defects, <http://cage.rti.org/glossary.cfm?cat=Patent+Defects>, 2006/10/13, a copy is attached as Exhibit C.) In contrast, "slipping property" in the present application means reduction of the friction coefficient of a printing paper in paper production processes (see page 1, line 26, through page 2, line 3, in the present application). Blocking involves nothing to do with the paper production processes, and sticking is clearly different from friction. Blocking is unrelated to slipping in the art.

Since Toyoda does not provide a motivation or suggestion to use an anti-blocking agent as a slipping agent, not all limitations of claim 6 are taught or suggested by Toyoda. Accordingly, claim 6 cannot be *prima facie* obvious over Toyoda.

Appl. No. : **10/509,226**
Filed : **April 14, 2005**

Third, by using the slipping agent recited in claim 6, both static and dynamic friction coefficients can be reduced without generating scum (an agglutinated product when the dispersion stability drops and a shearing load is applied in the coating process) in paper manufacturing. These surprising effects are demonstrated in Table 2 on page 24 of the instant specification and cannot be reasonably expected from Toyoda.

Fourth, as discussed above, the Examiner states: "Toyoda does not teach the claimed coating weight. However, Toyoda teaches the particles should be included in an ink composition." However, Toyoda does not teach or suggest the coating weight recited in claim 6. Toyoda states that an ink is coated on the base material so as to have 3-4 μm of desiccation [dry film] thickness (paragraph [0140]). In general, polymers roughly have a density of 1 g/cm^3 (dry), and thus, if the ink is applied to the entire paper surface at a thickness of $3\text{-}4 \mu\text{m}$, the weight of the ink will be 3-4 g/m^2 ($3\text{-}4 \mu\text{m} \times 1 \text{ m} \times 1 \text{ m} \times 1 \text{ g/cm}^3 = 3\text{-}4 \text{ g/m}^2$). In contrast, in claim 6, a clear coating is used in an amount as small as 0.001 to 1 g/m^2 . A feature in claim 6 is to have an excellent slipping property by using a clear coating in an amount as small as 0.001 to 1 g/m^2 .

Thus, not all limitations of claim 6 are taught or suggested by Toyoda. Accordingly, claim 6 cannot be *prima facie* obvious over Toyoda.

In view of the foregoing, claim 6 cannot be obvious over Toyoda. Claims 3-5, 9, 11-13, and 16-22 depend directly or ultimately from claim 6, and at least for this reason, claims 3-5, 9, 11-13, and 16-22 also cannot be obvious over Toyoda. Claim 14 recites the limitations discussed above in relation to claim 6 and further recites an additional limitation, and thus claim 14 cannot be obvious over Toyoda. Applicant respectfully requests withdrawal of the rejection.

Rejection of Claims 6, 3, 4, 9, 13, 16-20, and 22 Under 35 U.S.C. § 103

Claims 6, 3, 4, 9, 13, 16-20 and 22 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Asahi (JP55-039329A) in view of Ricoh (JP59174850A).

Please note that Asahi (JP55-039329A) has not been made of record in any PTO-892 Form or any IDS. Further, although the Examiner cites the English abstract of Asahi, a copy of the English abstract was not attached to the Office Action, and Applicant is not able to obtain a copy of the English abstract from the JPO or other source. Applicant requests that a copy of the English abstract upon which the Examiner relies be provided to Applicant for review.

Appl. No. : **10/509,226**
Filed : **April 14, 2005**

Nevertheless, independent claim 6 has been amended to incorporate the limitation of claim 15 which has not been rejected on this ground, and thus, this rejection is no longer applicable to claim 6 and the remaining dependent claims.

Claims 6, 3, 4, 9, 13, 16-20 and 22 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Sumitomo (JP51-04330A) in view of Ricoh (JP29174850A).

Claims 6, 3, 4, 9, 13, 16-20 and 22 have been rejected under 35 U.S.C. § 103 (a) as being unpatentable over Asahi (JP55-040835) in view of Ricoh (JP29174850A).

As described above, independent claim 6 has been amended to incorporate the limitation of claim 15 which has not been rejected on the above grounds, and thus, the above rejections are no longer applicable to claim 6 and the remaining dependent claims.

Rejection of Claims 5, 11, and 12 Under 35 U.S.C. § 103

Claims 5, 11, and 12 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Asahi (JP55-039329A), Asahi (JP55-040835), Sumitomo (JP51-04330A) in view of Ricoh (JP29174850A) and Kato (US5995785). As described above, claim 6 has been amended to incorporate the limitation of claim 15 which has not been rejected on this ground, and claims 5, 11, and 12 which depend ultimately from claim 6 cannot be obvious over the above references, alone or combined.

Appl. No. : 10/509,226
Filed : April 14, 2005

CONCLUSION

In light of the Applicant's amendments to the claims and the foregoing Remarks, it is respectfully submitted that the present application is in condition for allowance. Should the Examiner have any remaining concerns which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

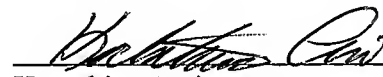
Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: January **3**, 2007

By:



Katsuhiro Arai

Registration No. 43,315

Attorney of Record

Customer No. 20,995

(949) 760-0404

3228983_3
122306